



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,578	09/18/2000	Stephen C. Roderick	130244	3952

25943 7590 02/24/2005

SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITES 1600-1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

EXAMINER

BASHORE, WILLIAM L

ART UNIT PAPER NUMBER

2176

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,578

Applicant(s)

RODERICK, STEPHEN C.

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7,9-11,13,14,18-20,23,25-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7,9-11,13,14,18-20,23,25-29 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This non-final action is responsive to communications: amendment filed 10/4/2004, to the original application filed 9/18/2000, IDS filed 1/4/2002. Application is a continuation of U.S. Application serial no. 09/228,259 filed 1/11/1999 (now U.S. Patent No. 6,122,648).
2. The examiner acknowledges Applicant's submission of Terminal Disclaimer filed 10/4/2004 to overcome an obviousness type double patenting rejection. However, as of this date, said terminal disclaimer has not been examined by the USPTO Paralegal department. Accordingly, the examiner cannot consider withdrawal of said Double Patenting rejection until at least a decision to accept said disclaimer is rendered by said department.
3. The objection to the Specification regarding inclusion of hyperlinks has been withdrawn as necessitated by amendment.
4. Claims 3-7,9-11,13,14,18-20,23,25-29 and 31-34 pending. Claims 1-2, 8, 12, 15-17, 21-22, 24 have been canceled. Claims 27-34 have been added. Claims 27, 29, 32 are independent claims.

Claim Objections

5. Claim 7 is objected to because of the following: claim 7 claims dependency upon a canceled claim. The following rejections under 35 U.S.C. 103(a), as well as Double Patenting rejections, will be based upon a possible interpretation of claim 7 as an apparatus claim which claims dependency from independent claim 27. Appropriate correction is required.
6. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must

Art Unit: 2176

not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Regarding the instant claims, it is noted that claim 30 is missing. Although the examiner can renumber the claims, the dependency tree is too complex in this case for the examiner to do so (too many claims, including their respective dependencies, need to be altered). Although the following rejections under 35 U.S.C. 103(a), as well as Double Patenting rejections, will be based upon a possible interpretation of the pending claim numbering as it presently stands, nevertheless, appropriate correction is required.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Pending claims 3-7,9-11,13,14,18-20,23,25-29 and 31-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No.

Art Unit: 2176

6,122,648 (hereinafter Roderick '648). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following.

In regard to pending independent claims 27, 29, 32, claims 1, 8, 14 of Roderick '648 teaches an apparatus, method, and article of manufacture with storage device for querying an information server, retrieving information, and dynamically generating instructions requesting a page if said page does not exist, as well as a url with server and identifier.

Roderick '648 does not specifically teach a "resource identifier". However, claims 1, 8, 14 of Roderick '648 teaches a real estate identifier, which suggests a resource identifier. It would have been obvious to one of ordinary skill in the art at the time of the invention for Roderick '648 to use said resource identifier, providing Roderick '648 the benefit of said identifiers for more accurate queries.

In regard to pending dependent claims 3-7, 9-11, 13-14, 18-20, 23, 25-26, 28, 31, 33-34, claims 2-7, 9-13, 15-18 of Roderick '648 teach the pending claimed limitations substantially as claimed.

In addition, Roderick '648 does not specifically teach "ISPID", or "VIN" codes. However, claims 1, 8, 14 of Roderick '648 teach a real estate identifier, which suggests various forms of identifiers (i.e. ISPID, VIN, UPC, etc.). It would have been obvious to one of ordinary skill in the art at the time of the invention to use said various identifiers in order to broaden the scope of querying.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 27, 29, 32, 3-4, 6-7, 13-14, 18, 23, 28, 31, 33, 34 are rejected under 35 U. S. C. 103 (a) as being unpatentable over Blinn et al (5,897,622), in view of Nazem et al (5,983,227), and in view of Bijnagte (5,235,680) (said three references listed on Applicant's IDS).

As per independent apparatus claim 27 (and similarly, method claim 29, and storage medium claim 32), and dependent claims 6, 28, 31, 33, Blinn discloses processing queries, including the dynamic generation of web pages (see columns 3-4), in which a page is composed for display by processing a template having a request for information from an order.

Refer also to Blinn's figures 1, 2, 3A, 3B, 5, 10, 12, 14, in which various embodiments illustrating the operation of the dynamic page generator are disclosed, including a processor, storage device, presenting (i.e. provisioning) information to a user etc.. It is, noted that Blinn fails to disclose:

- (1) dependence upon whether or not the page already exists;
- (2) "resource identifier".

However, Nazem discloses (see abstract, figure 2) a user template that is either generated from user preferences or retrieved from a cache of recently used user templates.

Bijnagte discloses communicating real estate information (a resource identifier) between a host computer and a remote display terminal (see abstract).

It would have been obvious to one of ordinary skill in the art to combine the inventions to Blinn, Nazem, and Bijnagte in arriving at the instant invention because it would be faster to transmit a page that already exists (as in the use of Nazem's cache) rather than always re-create pages that already exist (as in Blinn's invention). It would have been obvious to one of ordinary skill in the art to apply Blinn and Nazem to the field of real estate marketing (as in Bijnagte's invention) because it was well known at the time of the invention to provide such information on the Internet. It would also allow realtors to provide custom templates for individual clients for the purpose of showing properties.

In addition, although Blinn teaches a URL with a server and various identifiers (Blinn column 7 lines 14-26), Blinn does not specifically teach a resource identifier immediately following a server name. However, Nazem teaches a URL with a server name (quote.yahoo.com) with a resource identifier call to Dow Jones immediately after said server (quotes?SYMBOLS=^DJI&detailed=t) (see Nazem column 13 near middle of table listing). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Nazem to Blinn, providing Blinn the benefit of adaptation to various types of URL resource calls.

As per dependent claims 3-4 and 7-8, (and similarly, claims 13-14, 18, and 23, 34), it is noted that Blinn and Nazem fail to teach details of "real estate identifier". However, it would have been obvious to one of ordinary skill in the art at the time of the invention to teach such details in view of Bijnagte's disclosure, which is directed toward providing real estate information, and in view of Blinn's disclosure of processing merchant information (see columns 7-12, e.g., column 10, lines 5 et seq--The merchant system 120 provides a set of HTML pages dynamically generated from queries to a database 121 having store information, such as inventory data, advertising copy, product images, pricing, customer information and promotions.) One of ordinary skill in the art would be motivated to process queries that include "ISPID", etc., in order to help the user to narrow searches.

11. **Claims 9-11, 19-20, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blinn et al (5,897,622), Nazem et al (5,983,227), Bijnagte (5,235,680) as applied to claims 27, 29, 32 above, and further in view of Anderson et al (5,974,396) (listed on Applicant's IDS).**

As per dependent claims 9-11, 19-20, and 25-26, it is noted that Blinn, Nazem, and Bijnagte fail to disclose "compiling and maintaining statistics" based on the marketing code or "report function". However, refer to Anderson's abstract; figures 1, 6, 12A, and 13; and columns 5-12. Anderson discloses gathering and analyzing

customer and purchasing information based on buying habits, needs, demographics, etc. Anderson's system is used to generate reports in response to retailer queries. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Anderson with those of Blinn, Nazem, and Bijnagte in arriving at the instant invention because it would allow realtors to conveniently gather demographic details and other marketing data for their clients and for the realtors themselves.

12. Claim 5 is rejected under 35 U. S. C. 103 (a) as being unpatentable over Blinn et al., Nazem et al, and Bijnagte, as applied to claim 27 above, and further in view of Kirkevold et al. (6,263,322).

As per dependent claim 5, Blinn et al. does not specifically teach a VIN code. However, Kirkevold et al. teaches querying via VIN code (Kirkevold et al. column 17 lines 35-56). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Kirkevold et al. to Blinn et al., providing Blinn et al. the benefit of vehicle identification as part of resource identifiers, to broaden the scope of querying.

Response to Arguments

13. Applicant's arguments filed 10/4/2005 have been fully and carefully considered but they are not persuasive.

Applicants amendment to the Specification filed 10/4/2004 is acknowledged and accepted. See paragraph 2 above regarding Double Patenting rejection.

Applicant argues on page 11 of the amendment that the cited references do not teach Applicant's amended claim limitations. Nazem teaches a URL with a server name (quote.yahoo.com) with a resource identifier call to Dow Jones placed immediately after said server, separated by a "/" mark (quotes?SYMBOLS=^DJI&detailed=t) (see Nazem column 13 near middle of table listing).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Bashore

WILLIAM L. BASHORE
PATENT EXAMINER
TECH CENTER 2100

February 21, 2005